

REMARKS

This paper is responsive to a Non-Final Office action dated August 9, 2006. Claims 1-26 were examined. Claim 18 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 3, 5, 6, 9-11, 22, and 24 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U. S. Patent Application Publication No. 2002/0090963 to Avalos et al. (hereinafter, "Avalos"). Claims 12, 15-21, 26, and 26 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U. S. Patent Application Publication No. 2003/0119532 to Hatch. Claims 2 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Avalos in view of U. S. Patent Application Publication No. 2003/0172121 to Evans et al. Claims 4, 7, 8, and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Avalos in view of U. S. Patent Application Publication No. 2003/0016639 to Kransmo et al.

Rejections Under 35 U.S.C. § 112, second paragraph

Claim 18 is amended to depend from claim 15. Applicant respectfully maintains that amended claim 18 satisfies the requirements under 35 U.S.C. § 112, second paragraph. Accordingly, Applicant respectfully requests that the rejection of claim 18 be withdrawn.

Rejections Under 35 U.S.C. § 102

Claims 1, 3, 5, 6, 9-11, 22, and 24 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U. S. Patent Application Publication No. 2002/0090963 to Avalos et al. (hereinafter, "Avalos").

Claim 1 is amended to incorporate limitations of claim 2. Regarding amended claim 1, Applicant respectfully maintains that Avalos, alone or in combination with other references of record fails to teach or suggest

forwarding an electronic message to a first communications device, the forwarding in response to at least an indication of unsuccessful delivery of a short message service (SMS) message to a destination

communications device, wherein the first
communications device is incompatible with SMS,

as required by amended claim 1. The Office action admits that Avalos fails to teach or suggest that the first communications device is incompatible with SMS. Accordingly, Applicant respectfully requests that the rejection of claim 1, and all claims dependent thereon, under 35 U.S.C. § 102(b) be withdrawn.

Regarding claim 5, Applicant respectfully maintains that Avalos fails to teach or suggest that

the forwarding is enabled from a web browser,

as required by claim 5. The Office action relies on paragraph 0028, lines 1-21 of Avalos to supply this teaching. This portion of Avalos teaches that

[u]pon determining that the forwarding feature has been activated unconditionally, the forwarding destination, which in this case is an Internet address, is returned in the smsrequest response in step 245. It is important to note that in this instance, as well as in that illustrated in FIG. 2, the forwarding feature has been activated unconditionally, and therefore, whether the intended recipient (i.e., entity "B") is busy or not responding does not matter.

Paragraph 0028, lines 11-20. Although Avalos teaches determining whether a forwarding feature is activated and a forwarding destination being an Internet address, Avalos fails to state that forwarding is enabled from a web browser, as claimed. Rather, Avalos teaches activating a

forwarding feature in FIG. 1A, 1B, and 1C by a subscriber operating a mobile station (FIG. 1A), an autonomous registration step of the mobile station (FIG. 1B), interactions by the mobile station and an MSC/VLR (FIG. 1C), or by command of the service provider operator.

Paragraphs 0020-0023. Nowhere does Avalos teach or suggest that the forwarding is enabled from a web browser, as claimed. Accordingly, Applicant respectfully requests that the rejection of claim 5 under 35 U.S.C. § 102(b) be withdrawn.

Claims 12, 15-21, 25, and 26 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U. S. Patent Application Publication No. 2003/0119532 to Hatch (hereinafter, "Hatch").

Claim 12 is amended to incorporate limitations of claim 2. Regarding amended claim 12, Applicant respectfully maintains that Hatch fails to teach or suggest

a short message service (SMS) management facility that communicates an electronic message to a first communications device in response to an indicator of an unsuccessful delivery of the short message to a destination communications device, wherein the first communications device is incompatible with SMS,

as required by amended claim 12. Accordingly, Applicant respectfully requests that the rejection of claim 12, and all claims dependent thereon, under 35 U.S.C. § 102(e) be withdrawn.

Claim 25 is amended to incorporate limitations of claim 26. Claim 26 is canceled. Regarding amended claim 25, Applicant respectfully maintains that Hatch fails to teach or suggest

means for forwarding an electronic message to a first communications device, the forwarding in response to at least an indicator of unsuccessful delivery of a short message service (SMS) message to a destination communications device and means for formatting the electronic message as a message having a format compatible with the first communications device,

as required by amended claim 25. Accordingly, Applicant respectfully requests that the rejection of claim 25, and all claims dependent thereon, under 35 U.S.C. § 102(e) be withdrawn.

Rejections Under 35 U.S.C. § 103

Claims 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Avalos in view of U.S. Patent Application Publication No. 2003/0172121 to Evans et al. (hereinafter, "Evans"). Regarding amended claim 1, which is claim 2 in independent form, Applicant respectfully maintains that Avalos, alone or in combination with Evans fails to teach or suggest

forwarding an electronic message to a first communications device, the forwarding in response to at least an indication of unsuccessful delivery of a short message service (SMS) message to a destination communications device, wherein the first communications device is incompatible with SMS,

as required by amended claim 1. The Office action admits that Avalos fails to teach or suggest that the first communications device is incompatible with SMS and relies on Evans to supply this teaching. Evans fails to compensate for the shortcomings of Avalos. Evans teaches techniques for providing multimedia messages to incompatible terminals. Abstract. Evans teaches that terminals incompatible with multimedia messages include SMS terminals with web access. Paragraph 0032, lines 7-10. Nowhere does Evans teach or suggest that the first communications device is incompatible with SMS, as required by amended claim 1.

In addition, Applicant respectfully maintains that the Office action fails to provide a proper rationale for combining Avalos with Evans and thus impermissibly introduces hindsight into the obviousness analysis. In particular, the Office action states that because Evans teaches a communication terminal that is SMS incapable, it would be obvious to modify Avalos with Evans to arrive at the invention of amended claim 1. Applicant respectfully points out that “[d]efining the problem in terms of its solution reveals improper hindsight in the selection of prior art relevant to obviousness.” See Ecolochem Inc. v. S. Cal. Edison, 56 USPQ2d 1065, 1073 (Fed. Cir. 2000) (citations omitted). Indeed, “obvious to try” is not the standard.” See Ecolochem, 56 USPQ2d at 1075. Moreover, Avalos states that

[i]f the forwarding destination is not SMS capable, or is not a valid destination, then the user profile may be updated, prompting unsuccessful forwarding of the message, until such time as the forwarding destination becomes SMS capable. Alternatively, the user profile may not be updated, and notification of the unsuccessful profile update will be sent to the user (not shown).

Paragraph 0021 (emphasis added). Thus, Avalos teaches away from combination with Evans to forward an electronic message to a first communications device, the forwarding in response to at least an indication of unsuccessful delivery of a short message service (SMS) message to a

destination communications device, wherein the first communications device is incompatible with SMS, as applied by the Office action.

Since Avalos and Evans fail to teach or suggest limitations of claim 1, Applicant respectfully requests that the rejection of claim 1 and all claims dependent thereon, be withdrawn.

Claims 4, 7, 8, and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Avalos in view of U. S. Patent Application Publication No. 2003/0016639 to Kransmo et al. (hereinafter, “Kransmo”). Applicant respectfully maintains that claims 7, 8, and 23 depend from allowable base claims and are allowable for at least this reason.

Additional Remarks

Claim 5 is amended to be put in independent form.

Claims 23 and 24 are amended to depend from claim 5.

New claim 27 is added. Applicant believes that new claim 27 depends from an allowable base claim and is allowable for at least this reason.

In summary, all claims are believed to be allowable over the art of record, and a Notice of Allowance to that effect is respectfully solicited. Nonetheless, if any issues remain that could be more efficiently handled by telephone, the Examiner is requested to call the undersigned at the number listed below.

CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that, on the date shown below, this correspondence is being

- deposited with the US Postal Service with sufficient postage as first class mail and addressed as shown above.
- facsimile transmitted to the US Patent and Trademark Office.

_____ Date _____

EXPRESS MAIL LABEL: EV 735338402 US

Respectfully submitted,



Nicole Teitler Cave, Reg. No. 54,021
Attorney for Applicant(s)
(512) 338-6315 (direct)
(512) 338-6300 (main)
(512) 338-6301 (fax)